

REMARKS/ARGUMENT

Description of Amendments

In the specification, amendments have been made to correct typographic errors.

Applicants have amended claim 10 and added claims 17-28. No new matter has been added. As amended, claims 1-14 and 17-28 are now pending and under examination, and claims 15 and 16 are withdrawn.

The amendment to claim 10 is supported by the application as originally filed (see, for example, page 10, second paragraph). New claims 17-28 are also supported by the application as originally filed (page 10, second paragraph).

Objections to the Specification

There were three objections to the specification in the Office Action. The first two have been overcome by amendments to the specification, and the third objection is improper. In the third objection, the Examiner stated that the words “fluorinated alkanes” are repeated in the specification. Applicants’ review of the specification indicates that the words are NOT repeated. The specification actually states “fluorinated alkanes, fluorinated alkynes.” Therefore, withdrawal of the third objection is respectfully requested.

Rejection under 35 U.S.C. §103(a)

Claims 1-7 and 10-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Jacob* (U.S. Patent 5,087,418) in view of *Sirhan* (WO 03/037223). For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Of the rejected claims, claims 1 and 10 are independent claims. Independent claim 1 recites an apparatus to plasma coat a stent, which apparatus includes a mandrel supporting a stent, first and second plasma members, and a plasma generating source.

The Examiner stated that *Jacob* teaches every limitation of claim 1 except a mandrel supporting a stent. However, the Examiner contended that *Sirhan* teaches a glow discharge apparatus for film deposition on a stent that is supported by a mandrel. According to the Examiner, “it would have been obvious to one of ordinary skill in the art at the time of the invention to use a mandrel for processing a stent as taught by Sirhan et al in the apparatus of

Jacob during plasma processing as per the shape of the substrate to be processed.” For at least the following two reasons, Applicants respectfully disagree.

First, Applicants respectfully submit that the combined teaching of *Jacob* and *Sirhan* would not lead one of ordinary skill in the art to an apparatus to plasma coat a stent as recited in claim 1. *Jacob* discloses an apparatus for dry sterilization of medical devices and materials. *Sirhan* discloses a mandrel for mounting a stent. Placing the stent mandrel of *Sirhan* in the apparatus of *Jacob*, as the Examiner suggested, would simply result in an apparatus with a stent mandrel for dry sterilization of medical devices and materials. Such an apparatus might be suitable for dry-sterilizing a stent but not suitable for plasma-coating a stent. Indeed, this apparatus cannot coat a stent at all. Therefore, the combination of *Jacob* and *Sirhan* does not teach claim 1’s apparatus to plasma coat a stent.

Second, the Examiner failed to provide proper motivation to combine the teachings of *Jacob* and *Sirhan*. Where claimed subject matter is rejected as obvious in view of a combination of prior art references, a proper analysis under §103(a) requires, *inter alia*, consideration of whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed invention. *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). The Examiner stated that it would have been obvious to use the mandrel of *Sirhan* in the apparatus of *Jacob* during plasma processing as per the shape of the substrate to be processed. But the Examiner did not point out where in prior art such motivation exists. Indeed, such motivation could not have existed, because one of ordinary skill in the art would not have been motivated to place the mandrel of *Sirhan* in *Jacob*’s apparatus for dry sterilizing medical devices to create an apparatus for coating a stent. Accordingly, the Examiner has not established, and in fact cannot establish, the motivation required to combine the teachings of *Jacob* and *Sirhan* to arrive at the apparatus of claim 1.

Independent claim 10, as amended, recites a coating apparatus including, *inter alia*, a source that supplies a polymerizable monomer gas to the first tubular member. *Jacob* and *Sirhan*, either alone or in combination, do not teach such a source. Therefore, independent claim 10 is patentable over the cited art.

The dependent claims are patentable because they depend from patentable claim 1 or 10.

Claims 1, 8, and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Usai* (U.S. Patent 5,591,268) in view of *Sirhan* (WO 03/037223). For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

This rejection is similar to the above-discussed rejection. The Examiner stated that *Usai* teaches a plasma apparatus for processing wafers that includes every limitation of claim 1 except a mandrel supporting a stent. However, the Examiner contended that *Sirhan* teaches a glow discharge apparatus for film deposition on a stent that is supported by a mandrel. According to the Examiner, it would have been obvious to use a mandrel for processing a stent as taught by *Sirhan* in the apparatus of *Usai* during plasma processing as per the shape of the substrate to be processed. For at least the following two reasons, Applicants respectfully disagree.

First, Applicants respectfully submit that the combined teaching of *Usai* and *Sirhan* would not lead one of ordinary skill in the art to an apparatus of claim 1. *Usai* discloses an apparatus for manufacturing a semiconductor device. *Sirhan* discloses a mandrel for mounting a stent. Placing the stent mandrel of *Sirhan* in the apparatus of *Usai*, as the Examiner suggested, would simply result in an apparatus with a stent mandrel for manufacturing a semiconductor device. Such an apparatus, however, cannot coat a stent. Therefore, the combination of *Usai* and *Sirhan* does not teach claim 1's apparatus to plasma-coat a stent.

Second, the Examiner failed to provide proper motivation to combine the teachings of *Usai* and *Sirhan*. Where claimed subject matter is rejected as obvious in view of a combination of prior art references, a proper analysis under §103(a) requires, *inter alia*, consideration of whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed invention. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). The Examiner stated that it would have been obvious to use the mandrel of *Sirhan* in the apparatus of *Usai* during plasma processing as per the shape of the substrate to be processed. But the Examiner did not point out where in prior art such motivation exists. Indeed, such motivation could not have existed, because one

of ordinary skill in the art would not have been motivated to place the stent mandrel of *Sirhan* in *Usai's* apparatus for manufacturing a semiconductor device to create an apparatus for coating a stent. Accordingly, the Examiner has not established, and in fact cannot establish, the motivation required to combine the teachings of *Usai* and *Sirhan* to arrive at the apparatus of claim 1.

The dependent claims 8 and 9 are also patentable because they depend from claim 1.

Patentability of New Claims

New independent claim 24 recites an apparatus to plasma coat a stent, which apparatus has a plasma generating source that generates gaseous plasma to form a polymer film on a surface of the stent. The cited references, either alone or in combination, do not teach this feature. Additionally, claim 24 is patentable over the cited references for the same reasons as discussed above.

New dependent claims (i.e., claims 17-23 and 25-28) are also patentable, because they depend from patentable independent claims.

In light of the foregoing remarks, this application is considered to be in condition for allowance. If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 07-1850.

Respectfully submitted,

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